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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194115
Party	Defendant Marx, Robert
Correspondence Address	CARL E. CHRISTENSEN CHRISTENSEN LAW OFFICE PLLC 1422 W LAKE ST STE 216 MINNEAPOLIS, MN 55408-2616 carl@clawoffice.com
Submission	Answer and Counterclaim
Filer's Name	Carl E. Christensen
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Signature	/Carl E. Christensen/
Date	04/23/2010
Attachments	ZAFRIKA answer.pdf (7 pages)(84770 bytes)

Registration Subject to the filing

Registration No	3357945	Registration date	12/18/2007
Registrant	Latarie (Pty) Limited 146 Main Street Paarl, Cape Province, SOUTH AFRICA		

Goods/Services Subject to the filing

Class 033. First Use: 2007/05/30 First Use In Commerce: 2007/05/30
All goods and services in the class are requested, namely: Wines

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Latarie (Pty) Limited, v. Robert Marx,	Opposer/Plaintiff, Applicant/Defendant.	Opposition No. 91194115 Application No. 77832433 Mark: ZAFRIKA
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ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS

COME NOW Applicant Robert Marx (“Marx”) as and for his Answer to Latarie (Pty) Limited, (“Latarie”) states and alleges as follows:

1. Marx admits that Opposer is the holder of Registration No. 3357945 for the mark ZARAFA. Marx denies all other allegations in Paragraph 1 of the Opposition.
2. Marx admits the allegations in Paragraph 2 of the Opposition.
3. Marx admits the allegations in Paragraph 3 of the Opposition.
4. Marx admits the allegations in Paragraph 4 of the Opposition.
5. Marx admits the allegations in Paragraph 4 of the Opposition.
6. Marx admits that the labels for the ZARAFA brand wine, as imported by MT Global, LLC, are shown on the TTB forms attached as Exhibit C. Marx denies all other allegations in Paragraph 6 of the Opposition.
7. Marx admits that ZARAFA brand wine and ZAFRIKA brand wine are both distributed to Trader Joe’s in the United States. Marx denies all other allegations in Paragraph 7 of the Opposition.
8. Marx denies the allegations in Paragraph 8 of the Opposition.

9. Marx denies the allegations in Paragraph 9 of the Opposition.

AFFIRMATIVE DEFENSES

10. Opposer has falsely claimed that it is the source or origin of the ZARAFA-branded goods, and has falsely claimed to have used the ZARAFA mark in commerce in the U.S.
11. Opposer has committed Fraud on the USPTO.
12. Opposer has unclean hands: Opposer has brought this opposition to wrest control of Applicant's customers.

COUNTERCLAIMS

COUNT I: The ZARAFA Registration is Invalid.

13. Robert Marx is the CEO of MT Global, LLC, a licensed liquor importer and distributor located in Wyoming, Minnesota in the United States.
14. On or about 2003, Robert Marx ("Marx") had contacted Trader Joe's about developing an exclusive label wine of South African origin.
15. On or about 2003, Marx, through MT Global, LLC, discussed the idea of developing a wine for Trader Joe's with Devillard Britts ("Britts").
16. Britts is the owner of Latarie (Pty) Limited, Corporation in Paarl, Cape Province, in South Africa.
17. Marx relied on his knowledge of the Trader Joe's corporate culture and customer base to develop a line of wines to sell exclusively to Trader Joes.
18. Britts is a wine buyer who buys "juice," or un-bottled consumption-ready wine from other wineries.
19. Marx communicated the characteristics that he wanted in the line of wines to be marketed to Trader Joe's to Britts.

20. With this information, Britts prepared samples for MT Global, LLC.
21. On or about 2003, Britts sent wine samples to MT Global, LLC.
22. From these samples, Marx chose which of the samples would go into the bottles to be marked to Trader Joe's
23. Once Marx had chosen the wine to be put in the bottles to be marketed to Trader Joe's, he began the process of selecting the brand name for the wine.
24. Britts had recommended the name "Domestic Dog" for the brand name of the line of wines to be marketed to Trader Joe's.
25. Marx rejected this idea.
26. Marx shared with Britts that he wanted an name that captured the theme of Africa.
27. On or about 2003, Marx selected the name "Zarafa" for the wine that would be marketed to Trader Joe's.
28. On or about 2003, on Marx's recommendations, an artist was commissioned to develop the labels to be placed on the wine bottles.
29. From the six labels provided by the artist, Marx chose which label to be put on the wine.
30. On or about 2006, Trader Joe's contacted Marx and told him that ZARAFA was suffering from "label fatigue."
31. Trader Joe's indicated that it wanted to phase out ZARAFA and introduce a new budget line South African product.
32. Trader Joe's expressed interest in another brand that Marx was developing.
33. Marx introduced the new brand idea, and Trader Joe's approved it.

34. In the process of developing the new brand, Marx approached Trader Joe's to see if they would be interested in keeping the ZARAFA brand wine if he could "lift the quality of wine" and create a better tasting and looking product.
35. Marx again asked Britts to provide wine samples to MT Global, LLC so Marx could chose what to put in the improved ZARAFA brand wine.
36. Britts sent samples to Marx, and Marx selected which samples to use for the improved ZARAFA brand wine.
37. On or about summer of 2009, Britts began a campaign to phase Marx and MT Global, LLC out of the Trader Joe's account.
38. Britts contacted Trader Joe's directly and instructed them that he was replacing MT Global, LLC as the importer for Trader Joe's on the West Coast.
39. Upon information and belief, Trader Joe's did not consent to Britts' mandate.
40. Upon all times relevant Marx and MT Global, LLC was solely responsible for the use of the ZARAFA mark.
41. Upon all times relevant Marx and MT Global, LLC had exclusive control of the ZARAFA brand, including choosing that name to brand the wine he imported and sold to Trader Joe's.
42. Upon all times relevant Marx and MT Global, LLC had exclusive control of the quality of the wine bearing the ZARAFA mark, including changing the quality to suit the needs of Trader Joe's.
43. Upon all times relevant Marx and MT Global, LLC had exclusive control supply of the wine bearing the ZARAFA mark, including controlling the supply to meet the needs of Trader Joe's.

44. Upon all times relevant, the quality of the wine provided by Britts to Marx and MT Global, LLC for Trader Joe's was solely in the discretion of Marx.
45. Upon all times relevant, the brand name of the wine provided by Britts to Marx and MT Global, LLC for Trader Joe's was solely in the discretion of Marx.
46. Upon all times relevant Marx and MT Global, LLC was the source or origin of the ZARAFA brand wine.
47. Because MT Global, LLC had exclusive control of the ZARAFA brand wine, it had an implied license to use the ZARAFA mark.
48. Because MT Global, LLC had an implied license to use the ZARAFA mark, all use of the ZARAFA mark inured to MT Global, LLC.
49. When Latarie (Pty) Limited filed the ZARAFA mark on June 22, 2006 with the United States Patent and Trademark Office, it had no use of the ZARAFA brand wine.
50. When Latarie (Pty) Limited filed the ZARAFA mark on June 22, 2006, it attested under penalty of perjury that it had used the ZARAFA mark in commerce with respect to wine.
51. Because Latarie (Pty) Limited had no use of the ZARAFA mark upon filing the trademark registration for the ZARAFA mark, it has committed fraud on the U.S. Patent and Trademark Office.

WHEREFORE, this answering Applicant respectfully requests for the following actions from the TTAB:

1. Dismissal of the Opposition Action Number 91194115.
2. Cancellation of the Trademark Registration Number 3357945, registered on December 18, 2007, for the ZARAFA mark.

CHRISTENSEN LAW OFFICE PLLC

Dated: April 23, 2010

By: /s/Carl E. Christensen
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I hereby certify that on April 23, 2010, I caused the following documents:

- 1) Answer to Notice of Opposition; and
- 2) Counterclaims of Applicant.

to be filed electronically with the USPTO through ESTTA, and that ESTTA will send an e-notice of the electronic filing to the following:

Michael Culver

and on April 23, 2010, he served the above documents by placing in an envelope a true and correct copy of each document and depositing the envelope, with sufficient postage, in the United States Mail, addressed to the following parties

CHRISTENSEN LAW OFFICE PLLC

Dated: 4/23/2010

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